



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **OSAKADA, Akiyoshi**

Serial No.: 09/845,327

Filed: May 1, 2001

Group Art Unit: 2827

Examiner: MITCHELL, James M.

P.T.O. Confirmation No.: 2251

For. **HIGH-FREQUENCY CERAMIC PACKAGE**

RESPONSE UNDER 37 C.F.R. § 1.116
- EXPEDITED RESPONSE -
GROUP ART UNIT 2827

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November 8, 2002

Commissioner for Patents
Washington, D. C. 20231

Sir:

In response to the Office Action dated June 19, 2002, the period of response reset to run from August 9, 2002 by the October 10, 2002 Decision on Petition (Paper No. 10), applicant hereby requests reconsideration of the rejections in the Office Action.

However, as an initial matter, applicant renews his request to have the May 1, 2001 Information Disclosure Statement (IDS) considered by the Examiner. If some reason prevents the Examiner from reviewing the IDS, applicant requests that the Examiner explain the reason in the next Office Action.

Claims 1 and 3 stand are rejected under 35 U.S.C. § 103(a) as obvious over **Yamamoto et**

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Response

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al. (U.S. Patent No. 6,316,826) in view of prior art disclosed in the present application, referred to as admitted prior art (APA). Applicant respectfully traverses this rejection.

The rejection relies on the **Yamamoto et al.** metal member 4 to teach the claimed "first metal plate" and metal member 2 to teach the claimed "second metal plate." However, base claim 1 specifies that

... the thicknesses of said first and second metal plates [are] substantially equal, [and] said first and second metal plates [are] jointed at substantially the same level ...

It is acknowledged in the Office Action (page 2, bottom) that **Yamamoto et al.** do not "appear" to teach these features. Instead, the rejection is based on such features being an "obvious matter of design choice." (Office Action, page 4, top.)

However, the Office Action does not define the concept "obvious matter of design choice." Without such a definition, there is no justification of how the above-cited claimed features supposedly satisfy a test of "obvious matter of design choice."

The statute 35 U.S.C. § 103(a) does not define any "obvious matter of design choice" test for obviousness. Applicant acknowledges that the courts and the Manual of Patenting Examining Procedure (MPEP) often provide interpretations and guidance. However, the Office Action provides no reference to the "obvious matter of design choice" concept in either a legal (court) decision or in the MPEP.

The only reference applicant finds in the MPEP to "obvious matter of design choice" is the following:

In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice).

The MPEP provides this summary in section 2144.4 VI. C. regarding patentability when a variation of a prior art design is achieved by a rearrangement of parts. The legal decision In re Kuhle found unpatentable a variation from the prior art that "presents no novel or unexpected result [and which] solves no stated problem and would be an obvious matter of design choice within the skill of the art." 526 F.2d at 555.

Applicant of course acknowledges that an Examiner, to justify a rejection, may use rationale used by an appropriate court. Such practice is specifically addressed in MPEP § 2144.04 (see page 2100-130). However, the MPEP only allows this practice to situations where "the facts in a prior legal decision are sufficiently similar to those in an application under examination" (emphasis added). Therefore, it would not be appropriate to rely on In re Kuhle here if its facts are not sufficiently similar to those in the present application.

Applicant now submits that the facts of In re Kuhle are distinguishable from those of the present application as follows: In the present invention, having the thicknesses of the first and second metal plates substantially equal and having the first and second metal plates jointed at substantially the same level instead of as taught by **Yamamoto et al.** reduces the likelihood of

detrimental curl in the claimed high-frequency ceramic package. (See the specification, for example, page 3, bottom paragraph, and applicant's May 6, 2002 Amendment, pages 6 and 7.)

Because detrimental curl is reduced, it is therefore not true that the claimed relative size and arrangement of the first and second metal plates would not present a novel result. Therefore, In re Kuhle cannot be relied upon to justify the obviousness rejection. Further, because the Office Action provides no citation to the MPEP or to a legal decision defining the "obvious matter of design choice" test, applicants again assert that such test cannot be properly relied upon to deem claims 1 and 3 obvious.

Applicant acknowledges that four legal decisions are cited on page 4 of the Office Action. (Applicant also acknowledges that all four legal decisions are summarized in the MPEP on page 2100-131.) However, the Office Action does not show how the facts of any of the four cited decisions are sufficiently similar to those in the present application. Applicant submits that the facts are not sufficiently similar. Applicant can distinguish the facts of the cited decisions from those of the present application as follows:

In re Rose discusses limitations relating to size (requiring handling by a lift truck), and the claimed features referenced above do not specify an absolute size. The claims specify a relative size,¹ which is addressed by Gardner v. TEC Systems, Inc.

¹Therefore, the statement in the Office Action, page 4, that "applicant has not disclosed that the dimensions are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical" (emphasis added) does not support the rejection, because the claims describe

Gardner v. TEC Systems, Inc. addresses the situation where the only difference between the prior art and the claims was a recitation of relative dimensions, and a device having the claimed relative dimensions would not perform differently than the prior art device.

However, the relative dimensions are not the only difference between the prior art and the claims. The claims also recite that the first and second metal plates are jointed at substantially the same level, unlike in **Yamamoto et al.** Also, as discussed above, a device having the first and second metal plates jointed at substantially the same level and also having the claimed relative dimensions would perform differently (less detrimental curl).

Therefore, because the relative dimensions is not the only difference between the prior art and the claims, and because the claimed would perform differently than the prior art device, Gardner v. TEC Systems, Inc. cannot support the obviousness rejection.

In re Rinehart discusses scaling a prior art process capable of being scaled up. Applicant does not claim scaling a prior art process. Therefore, the In re Rinehart facts are dissimilar to those of the present invention.

In re Dailey discusses a situation in which there was no persuasive evidence that the claimed configuration was significant. As explained above, however, applicant's claimed configuration is significant, because the invention performs differently by not curling to the same extent as in relative dimensions.

Yamamoto et al. Therefore, In re Dailey also cannot support the obviousness rejection.

In view of the distinctions between the facts of the cited court decisions and those of the present invention, applicant submits that the court decisions cited in the Office Action cannot support the obviousness rejection.

Applicant notes the discussion in the Office Action of product-by-process claim interpretation. Regardless of the validity of the interpretation, the claims are distinguishable from the applied prior art for other reasons, as shown above.

In view of the lack of the Office Action to support the obviousness rejection using any support from the MPEP, court decisions, or the plain text of the obviousness statute itself, applicant hereby solicits the withdrawal of the obviousness rejection of claims 1 and 3 under 35 U.S.C. § 103(a).

Claim 2 stands rejected under 35 U.S.C. § 103(a) as obvious over **Yamamoto et al.** and the admitted prior art (APA), and further in view of **Bergstedt et al.** (Application US 2001/0004132 A1). Applicant respectfully traverses this rejection.

Claim 2 depends from claim 1, which should be allowable for the reasons provided above. Therefore, claim 2 should be allowable for at least the reason of its dependency from claim 1.

Applicant acknowledges that the rejection of claim 2 relies additionally on **Bergstedt et al.** However, **Bergstedt et al.** is not relied upon to remedy the deficiency of **Yamamoto et al.** to properly justify the rejection of parent claim 1.

Also, applicant provides an additional reason to withdraw the rejection of claim 2: The prior art reference **Bergstedt et al.** was filed December 15, 2000, and the priority date claimed for the present application is September 20, 2000. To obtain the benefit of the priority date, applicant submits a verified translation of the Japanese priority document concurrently with the present Request for Reconsideration.

Accordingly, for both the reason that claim 2 depends from claim 1 and the reason that applicant submits a verified translation of the Japanese priority document, withdrawal of the obviousness rejection of claim 2 is now requested.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as obvious over **Yamamoto et al.** and the admitted prior art (APA), and further in view of **Nebe et al.** (U.S. Patent No. 5,167,869). Applicant respectfully traverses this rejection.

Claim 4 depends from claim 1, which should be allowable for the reasons provided above. Therefore, claim 4 should be allowable for at least the reason of its dependency from claim 1. Applicant acknowledges that the rejection of claim 4 relies additionally on **Nebe et al.** However, **Nebe et al.** is not relied upon to remedy the deficiency of **Yamamoto et al.** to properly justify the

rejection of parent claim 1.

Accordingly, withdrawal of the obviousness rejection of claim 4 under 35 U.S.C. § 103(a) is now requested.

In view of the remarks above, applicant now submits that the entire application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested.

Before submitting the present Request for Reconsideration, applicant's representative telephoned the Examiner-of-record to request a personal interview to discuss the rejections. The Examiner was not able to grant the interview before the filing deadline, so this paper was filed first. Nonetheless, if for any reason the Examiner believes this application is not in condition for allowance, the he is requested to contact applicant's undersigned attorney at the telephone number indicated below to discuss the issues.

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In the event that this paper is not timely filed, applicant petitions for an appropriate extension of time. The fees for such an extension, or any other fees which may be due, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

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